

Appln. No. 10/808,080
Amendment dated October 10, 2005
Reply to Office Action mailed June 8, 2005

REMARKS

Reconsideration is respectfully requested.

Entry of the above amendments is courteously requested in order to place all claims in this application in allowable condition and/or to place the non-allowed claims in better condition for consideration on appeal.

Claim 10 remains in this application. Claims 1 through 9 and 11 through 13 have been cancelled. No claims have been withdrawn or added.

Claims 1 through 13 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Fikes in view of Lapworth.

Claim 10 requires, in part, "wherein said plurality of exhaust apertures are positioned on an opposite side of said flagpole from a mounting location of said blower assembly on said base member".

It is contended in the Office Action that:

Lapworth discloses a flag pole assembly wherein a plenum in element 14 is offset from the blower assembly in order to redirect the air from the blower to the flag pole, that the blower motor can be sat upon the same base as the flagpole and offset from the flagpole opposite the flag and its supporting eyehooks and clip members. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the base member, taught by Fikes, to place the blower separate to and attached to a perimeter face and side thereof, as suggested by Lapworth and also by Fikes via the embodiment of figure 1, and opposite the flag, the eyehooks, the clip members and the exhaust apertures, as taught by Lapworth, in order to produce a smaller and lighter overall assembly that will allow the flag to blow in the intended direction while offsetting the imbalance created by a blowing flag.

Thus, the rejection of the Office Action relies upon an allegedly obvious combination of the Fikes with Lapworth in an attempt to assemble the combination of elements required by applicant's claim 10.

It is significant to note that the courts have recognized that most elements of inventions can be found somewhere in the prior art.

Appln. No. 10/808,080
Amendment dated October 10, 2005
Reply to Office Action mailed June 8, 2005

Most if not all inventions arise from a combination of old elements. See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998).

In re Kotzab, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000).

And thus the ability to find each one of the claimed elements in the prior art does not in and of itself negate patentability.

Thus, every element of a claimed invention may often be found in the prior art. See *id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

In re Kotzab, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000).

The Office Action sets forth a number of reasons that are alleged to support the combinations of the various parts of the cited references. However, these reasons do not appear to be taken from the prior art, but from an ex post facto analysis of the combination of the features disclosed in the applicant's application, and possible benefits of the applicant's invention applied to the prior art parts.

In particular, it is alleged in the Office Action that the modification suggested in the rejection would "produce a smaller and lighter overall assembly that will allow the flag to blow in the intended direction while offsetting the imbalance created by a blowing flag". However, neither Fikes nor Lapworth recognizes (or purports to solve) any such imbalance problem, particularly any caused by a blowing flag, and the Office Action does not give any indication in the prior art where such a problem is pointed out or where it is stated that the Lapworth design solves such a problem. To the contrary, this "problem" and "solution" is only found in the specification of

Appln. No. 10/808,080
Amendment dated October 10, 2005
Reply to Office Action mailed June 8, 2005

the present patent application, particularly at page 6, lines 14 through 20. Therefore, since the prior art itself is silent as to such a problem, the rejection of the Office Action points to nowhere in the prior art that identifies the problem, and the only mention of such a problem is in the disclosure of the present application, it is submitted that one can only draw the conclusion that the Examiner has relied upon prohibited hindsight reconstruction to attempt to motivate one of ordinary skill in the art to make the allegedly obvious modification of Fikes with some carefully selected relationships from Lapworth, as the prior art is at a loss to explain such a modification.

However, a motivation must be provided by the prior art to make the allegedly obvious combinations of parts relied upon in making an obviousness rejection.

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc. , 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998).

In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Absent a showing of motivation in the prior art to make the allegedly obvious combination, it can only be assumed that the applicant's disclosure has provided the motivation for making the combination of elements from the prior art, and not the prior art itself.

Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight. See, e.g., Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985).

In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

It is therefore submitted that the combination of individual parts taught by the various prior art references relied upon in the Office Action

Appln. No. 10/808,080
Amendment dated October 10, 2005
Reply to Office Action mailed June 8, 2005

would not motivate one skilled in the art to arrive at the applicant's claimed invention.

Withdrawal of the §103(a) rejection of claim 10 is therefore respectfully requested.

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

WOODS, FULLER, SHULTZ & SMITH P.C.



Jeffrey A. Proehl (Reg. No. 35,987)
Customer No. 40,158
P.O. Box 5027
Sioux Falls, SD 57117-5027
(605)336-3890 FAX (605)339-3357

Date: Oct. 10, 2005